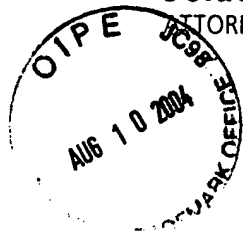


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August 10, 2004

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Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Art Unit 2856

Re: U.S. Utility Patent Application
Appl. No. 10/772,470; Filed: February 6, 2004
For: **Vacuum Membrane Extraction System**
Inventors: LaCOURSE *et al.*
Our Ref: 2254.0010001/RWE/JKM

Sir:

Transmitted herewith for appropriate action are the following documents:

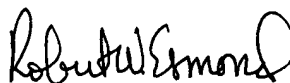
1. Reply to Restriction Requirement; and
2. One (1) return postcard.

It is respectfully requested that the attached postcard be stamped with the date of filing of these documents, and that it be returned to our courier. In the event that extensions of time are necessary to prevent abandonment of this patent application, then such extensions of time are hereby petitioned.

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036.

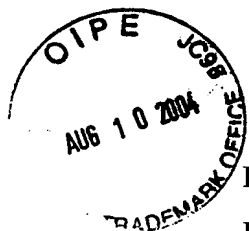
Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



Robert W. Esmond
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Registration No. 32,893

RWE/JKM:bac
297147_1.DOC



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

LACOURSE *et al.*

Appl. No. 10/772,470

Filed: February 6, 2004

For: **Vacuum Membrane Extraction
System**

Confirmation No.: 6717

Art Unit: 2856

Examiner: Raevis, R.R.

Atty. Docket: 2254.0010001/RWE/JKM

Reply to Restriction Requirement

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In reply to the Office Action dated July 13, 2004, requesting an election of one invention to prosecute in the above-referenced patent application, Applicants hereby provisionally elect to prosecute the invention of Group II, represented by claims 3, 5 and 6. This election is made without prejudice to or disclaimer of the other claims or inventions disclosed. Applicants note that the Examiner has indicated that claims 1, 7, 8, 10-14 and 20 link groups I-VIII. Thus, these claims should also be examined along with claims 3, 5 and 6 in Group II.

This election is made **with** traverse. Reconsideration and withdrawal of the restriction requirement, and consideration of all pending claims, are respectfully requested.

The criteria for a proper requirement for restriction are that (1) the inventions must be independent or distinct as claimed; *and* (2) there must be a serious burden on the Examiner if restriction is not required. MPEP § 803 (emphasis added). The two requirements for restriction set forth in MPEP § 803 are connected with "and." Accordingly, satisfaction of both criteria is required. Moreover, the "serious burden" must be shown by

demonstrating at least one of the following: a) separate classification of the subject matter; b) that the subject matter has attained separate status in the art when they are classifiable together; or c) different fields of search for the subject matter. *See* MPEP § 808.02.

Applicants respectfully assert that the claims in Groups I-IV are closely related in subject matter. As the Examiner has noted, Groups I-IV are related as combination and subcombination (*see* Restriction Requirement at page 3, third paragraph). As such, a search of one group of claims is likely to encompass subject matter pertinent to the patentability of all groups.

While the Examiner contends that the claims in Groups I-IV represent distinct inventions, he has not provided any showing as to why the examination of these claims would impose a serious burden. Applicants note that the claims in Groups I-IV are all classified within the same class, 73. In such a case, the Examiner must show by appropriate explanation either that the subject matter in the separate groups has obtained a separate status in the art (shown by citing patents which are evidence of such separate status and a separate field of search); or that the subject matter in the separate groups would require different fields of search. MPEP § 808.02(B) and (C).

In making this restriction requirement, the Examiner has not cited any evidence to support the allegedly separate status of these claims and that a separate field of search would be required, nor has the Examiner stated that the subject matter in groups I-IV would require different fields of search. Therefore, none of the three criteria in MPEP § 808.02 is met and when "the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among related inventions." MPEP § 808.02.

Hence, Applicants respectfully assert that a serious burden would not be imposed if restriction were not required as a search of one of these groups would likely encompass subject matter pertinent to the remaining groups. According to the guidance of the MPEP, "[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions." MPEP § 803. Applicants submit therefore that the Examiner has not satisfied the second requirement set forth in MPEP § 803.

Finally, it is improper to require restriction of a single claim. *See, In re Weber*, 198 U.S.P.Q. 332 (CCPA 1978) and *In re Hass*, 198 U.S.P.Q. 334 (CCPA 1978). These cases make it clear that 35 U.S.C. § 121 does not grant the authority to refuse to examine a claim that may read on separate inventions (i.e. linking claims 1, 7, 8, 10-14 and 20). Section 121 only applies to separate inventions claimed in different claims. Hence, reconsideration and withdrawal of the Restriction Requirement, and consideration of all pending claims, are respectfully requested.

If the Examiner still believes that restriction of the present invention is warranted, Applicants respectfully request that the Examiner combine the claims represented by Groups I-IV for examination as the claims in these groups are drawn to closely related subject matter.

It is not believed that extensions of time are required beyond those that may otherwise be provided for accompanying documents. However, if additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. §1.136(a), and any fees required therefor are hereby authorized to be charged to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

A handwritten signature in black ink, appearing to read "Robert W. Esmond". The signature is fluid and cursive, with the first name "Robert" and last name "Esmond" clearly distinguishable.

Robert W. Esmond
Attorney for Applicants
Registration No. 32,893

Date: August 10, 2004

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